UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,207	06/25/2003	Richard Douglas Kemp	336001-2024.1	2681

26999 7590 06/06/2008	EXAMINER	
FROMMER LAWRENCE & HAUG	PHAM, KHANH B	
745 FIFTH AVENUE- 10TH FL.		
NEW YORK, NY 10151	ART UNIT	PAPER NUMBER
	2166	

MAIL DATE	DELIVERY MODE
06/06/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>10 March 2008</u>.

2a)☒ This action is **FINAL**.　　2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
    closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-12,16-24,30,32-35 and 56-69</u> is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-12,16-24,30,32-35 and 56-69</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of:

　　　　1.☐ Certified copies of the priority documents have been received.

　　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
　　　　　　application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Claim Objections

1.   Claim 1 is objected to because of the following informalities: the phrase "in

association **with to** at least one" in line 11 should be changed to "in association with at

least one". Appropriate correction is required.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

3.   Claims 63-64 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

4.   Claims 63-64 recite the limitation "The system of claim 61" in line 1. There is

insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

6.   **Claims 1-12, 16-24, 30, 32-35, 56-69** are rejected under 35 U.S.C. 102(e) as

being anticipated by Lee et al. (US 6,839,707 B2), hereinafter "**Lee**".

       As per claim 1, Lee teaches at Fig. 1 a system for providing legal information

comprising associated items of legal information and content, the system comprising

- "at least one computer and a plurality of user terminal which communicate over a
  network" at Fig. 1;

- "at least one database associated with the at least one computer storing the legal
  information in association with a plurality of legal topics and a plurality of type of
  legal information at Col. 1 line 60 to Col. 2 line 54 and Figs. 3, 6, 7;

- "a computer readable medium or media storing programming that cause the at least
  one computer to access within the at least one database legal information in
  association with to at least one legal topic responsive to a request received from a
  user terminal" at Col. 2 lines 14-22 and Fig. 6;

- "and cause each item of legal information associated with the accessed information
  to be provided for display on a display device associated with the user terminal from
  which the request was received, tabulated by type of legal information and
  configured to be selectable at the user terminal to provide a request for display on
  the display device of the content associated with the selected item" at Col. 7 line 66
  to Col. 8 line 49 and Figs. 6-7.

As per claim 2, Lee teaches the system of claim 1, wherein "the plurality of types of legal information comprises at least two of: administrative action, legislative action, rulemaking, reported judicial decisions, and news" at Figs. 6-8.

As per claim 3, Lee teaches the system of claim 1, wherein "causing each item of legal information to be display comprises causing each item of legal information to be provided for display in a separate display window by type" at Fig. 6-8.

As per claim 4, Lee teaches the system of claim 3, wherein "the plurality of types of legal information comprises at least two of : "administrative action, legislative action, rulemaking, reported judicial decisions, court filings, news, and secondary materials" at Figs. 6-8.

As per claim 5, Lee teaches the system of claim 3, wherein "the plurality of types of legal information comprises at least: administrative action, legislative action, rulemaking, reported judicial decisions, court filings, news, and secondary materials" at Figs. 6-8.

As per claim 6, Lee teaches the system of claim 1, wherein "legal topics comprising at least two of: admiralty and maritime; alternative dispute resolution; antitrust; trade regulation; banking; finance; bankruptcy; business; commercial; consumer rights; corporate; business organizations; civil rights; collectibles and

personal property; communications; media; constitutional; construction; contracts;
criminal; education; employment; labor; entertainment; gaming; sports; environmental;
estates, trusts, and wills; family; government; elections and politics; government
benefits; government contracts; government administration; state government; local
government; health; human rights; immigration; insurance; intellectual property;
copyrights; patents; trademarks; international; international trade; internet; litigation;
litigation administration; appellate procedure; civil procedure; damages and remedies;
evidence; mergers and acquisitions; military; natural resources; energy; native
populations; professions and occupations; professional licensing; professional
responsibility; products liability; real property; science and technology; securities; US
federal taxation; state taxation; international taxation; torts; transportation; and workers'
rights" at Figs. 6-17.

    As per claim 7, Lee teaches the system of claim 1, wherein "the programming
causes the at least one computer to:

- "automatically access within the at least one database new legal information
  responsive to the request while each item of legal information associated with the
  previously accessed legal information is provided for display on the display
  device" at Col. 2 lines 7-22 and Fig. 6;

- "provide for display on the display device each item of legal information
  associated with the accessed new legal information together with each item of

legal information associated with the previously accessed legal information all
tabulated by type" at Fig.7.

As per claim 8, Lee teaches the system of claim 1, wherein "the programming
causes the at least one computer to :

- "automatically and periodically access the at least one database to determine
  whether new legal information responsive to the request is stored within the at
  least one database while each item of legal information associated with the
  previously accessed legal information is provided for display on the display
  device" at Col. 2 lines 7-22 and Fig. 6;
- "if new legal information responsive to the request is stored within the at least
  one database, provide for display on the display device each item of legal
  information associated with the new legal information together with each item of
  legal information associated with the previously accessed legal information all
  tabulated by type" at Fig. 7.

As per claim 9, Lee teaches the system of claim 1, wherein the programming
causes the at least one computer to :

- "automatically and continually access the at least one database to determine
  whether new legal information responsive to the request is stored within the at
  least one database while each item of legal information associated with the

previously accessed legal information is provided for display on the display
device" at Col. 2 lines 7-22 and Fig. 6;

- "if new legal information responsive to the request is stored within the at least
  one database, provide for display on the display device each item of legal
  information associated with the new legal information all tabulated by type" at
  Fig. 6.

As per claim 10, Lee teaches the system of claim 1, comprising "a plurality of
databases for storing the legal information, wherein the legal information is stored in
separate databases by legal topic" at Col. 1 line 60 to Col. 2 line 6.

As per claim 11, Lee teaches the system of claim 1, comprising "plurality of
databases for storing the legal information, wherein the legal information is stored in
separate databases by type of legal information" at Col. 5 lines 35-50 and Fig. 3.

As per claim 12, Lee teaches the system of claim 1, comprising "a plurality of
databases for storing the legal information, wherein the legal information is provided by
a plurality of sources, and the legal information is stored in separate databases
according to the source that provided the information" at Col. 9 lines 25-45.

As per claim 16, Lee teaches the system of claim 1, wherein "the programming causes the at least one computer to display on the display device tabulated by type each item of legal information provided for display"

As per claim 17, Lee teaches the system of claim 16, wherein "each item of legal information displayed on the display device is associated with a selectable link to the associated content, and wherein the programming causes the at least one computer to generate a request to retrieve the associated content from the at least one database in response to selection of a selectable link at the user terminal" at Col. 8 lines 35-48.

As per claim 18, Lee teaches the system of claim 57, wherein "the displayed content comprises a complete version of a document" at Col. 7 lines 5-30.

As per claim 19, Lee teaches the system of claim 57, wherein "the displayed content comprises an abbreviated version of a document" at Col. 5 lines 25-35.

As per claim 20, Lee teaches the system of claim 19, wherein "the abbreviated version of a document comprises a summary of a document" at Col. 7 lines 5-30.

As per claim 21, Lee teaches the system of claim 19, wherein "the abbreviated version of a document comprises at least one redacted portion of a document" at Col. 5 lines 25-35 and Col. 7 lines 5-30.

As per **claim 22**, Lee teaches the system of claim 16, wherein "the displayed content information comprises at least a partial image of a document" at Col. 7 lines 5-30.

As per **claim 23**, Lee teaches the system of claim 57, wherein "displayed content and a displayed item of information with which the displayed content is associated are displayed in different display windows" at Figs. 6-17.

As per **claim 24**, Lee teaches the system of claim 57, wherein "displayed content and displayed item of information with which the displayed content is associated are displayed in different monitor screens" at Col. 7 lines 35-45.

As per **claim 30**, Lee teaches a method of processing legal information, the method comprising:

- "assigning to each of a plurality of documents which each comprises legal information relating to a plurality of legal topics, at least one identifier associated with (a) at least one of the legal topics and (b) at least one of a plurality of types of legal information" at Col. 10 lines 34-44 and Figs. 6, 12;

- "formatting the documents according to a protocol; storing the formatted documents in at least one database" at Col. 9 lines 3-65;

- "using identifiers associated with the stored documents to identify documents within the at least one database responsive to a request received from a user

terminal for information related to at least one of the plurality of legal topics" at
Col. 10 lines 44-65;

- "causing legal information associated with the identified documents to be
  provided for display on the display device, tabulated by type" at Col. 10 line 65-
  67 and Fig. 7.

As per claim 32, Lee teaches the method of claim 30, wherein "documents are
stored in a plurality of databases" at Col. 9 lines 3-23.

As per claim 33, Lee teaches the method of claim 32, wherein "the documents
are stored in the plurality of databases according to at least one of: the topics in relation
to which respective document are stored, the type assigned to the documents, and a
source of the documents" at Col. 9 lines 3-43.

As per claim 34, Lee teaches the method of claim 30, comprising: "checking
formatted documents for compliance with a document receiving protocol; and
generating a notice of defects automatically upon determination that a checked
document does not comply with the protocol" at Col. 9 lines 55-65.

As per claim 35, Lee teaches the method of claim 34, comprising "automatically
performing the assigning and formatting steps on the non-complying document" at Col.
9 lines 55-65.

As per claim 56, Lee teaches the system of claim 16, wherein "the programming stored on the computer readable medium or media causes the at least one computer to provide for display on the display device content associated with a displayed item of legal information in response to selection thereof at the user terminal" at Col. 11 lines 12-35 and Fig. 6.

As per claim 57, Lee teaches the system of claim 56, wherein "the programming stored on the computer readable medium or media cause the at least one computer to display on the display device the content provided for display" at Fig. 6.

As per claim 58, Lee teaches a method for providing legal information comprising associated items of legal information and content in a system comprising at least one computer and a plurality of user terminals which communicate over a network, and at least one database associated with the at least one computer storing the legal information in association with a plurality of legal topics and a plurality types of legal information (Figs. 1-3, 6), the method comprising:

- "the at least one computer accessing within the at least one database legal information responsive to a request from a user terminal" at Fig. 1;

- "the at least one computer providing for display on a display device associated with the user terminal from which the request was received each item of legal information associated with the accessed information, tabulated by type of legal information and configured to be selectable at the user terminal to provide a

request for display on the display device of the content associated with the

selected item" at Fig. 1-3, 6.

As per claim 59, Lee teaches the method of claim 58, comprising "the at least

one computer displaying on the display device tabulate by type each item of legal

information provided for display" at Fig. 6.

As per claim 60, Lee teaches the method of claim 59, comprising "the at least

one computer providing for display on the display device content associated with a

displayed item of legal information in response to selection thereof at the user terminal"

at Col. 11 lines 11-35 and Figs. 6-17.

As per claim 61, Lee teaches the method of claim 60, comprising "the at least

one computer displaying on the displayed device the content provided for display" at

Figs. 6-17.

As per claim 62, Lee teaches the method of claim 59, wherein "displaying each

item of legal information comprises displaying each item of legal information in a

separate display window by type" at Fig. 6.

As per claim 63, Lee teaches the method of claim 61, wherein "displaying the content comprises displaying the content in a different display window than each associated displayed item" at Figs. 6-17.

As per claim 64, Lee teaches the method of claim 61, wherein "displaying the content comprises displaying the content in a different monitor screen than each associated displayed item" at Col. 11 lines 25-35 and Figs. 6-17.

As per claim 65, Lee teaches the method of claim 59, wherein "each item of legal information displayed on the display device is associated with a selectable link to associated content, the method comprising generating a request to retrieve the associated content by selection of a selectable link at the user terminal" at Col. 1- lines 55-67 and Fig. 6.

As per claim 66, Lee teaches the method of claim 58, comprising "the at least one computer: automatically accessing within the at least one database new legal information responsive to the request while providing for display each item of legal information associated with the previously accessed legal information; and providing for display on the display device each item of legal information associated with the accessed new legal information together with each item of legal information associated with the previously accessed legal information all tabulated by type" Col. 2 lines 7-22 and Fig. 6.

As per claim 67, Lee teaches the method of claim 60, comprising the at least

one computer: automatically and periodically accessing the at least one database to

determine whether new legal information responsive to the request is stored within the

at least one database while each item of legal information associated with the

previously accessed legal information is provided for display on the display device; and

if new legal information responsive to the request is stored within the at least one

database, providing for display on the display device each item of legal information

associated with the new legal information together with each item of legal information

associated with the previously accessed legal information all tabulated by type" at Col. 2

lines 7-22 and Fig. 6.

Response to Arguments

7.   Applicant's arguments filed 3/10/2008 have been fully considered but they are

not persuasive. The examiner respectfully traverses applicant arguments.

8.   Regarding claim 1, applicant argued that Lee does not teach providing items of

legal information for display "tabulated by type of legal information". On the contrary,

Lee teaches at Fig. 6 a plurality of items of legal information (i.e. 340, 350, 380, etc.)

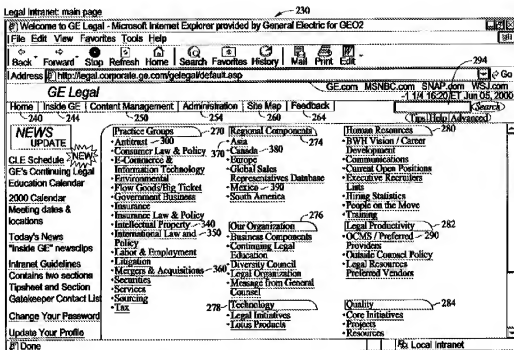tabulated by type of legal information (i.e. 270, 274, 278.)

FIG. 6

Applicant argued that Fig. 6 of Lee depicts a display with entries under the heading "Practice Groups", "Regional Components",... are not "type of legal information" because there is no disclosure in Lee that information in the items under "Practice Group" all relate to the same type of legal information. On the contrary, Lee teaches at Col. 8 lines 25-35 that: "Practice Group 270 is further organized into several different groups such as Antitrust 300, Intellectual Property 340, International Law and Policy 350, and Merges and Acquisitions 360." Therefore, all items of legal information 300, 340, 350, 360 relate to the same type of legal information, which is "Practice Group" 270.

In view of applicant's specification, "type of legal information" referrers to different types or classes of information to which the information belongs. Applicant's Fig. 4 shows that legal information items 401, 402, 403 are grouped under different headings

such as "Administrative Action" 430, "Current Following" 431, "Security News" 432,

which are called "type of legal information" by applicant. However, these headings are

simply just labels to identify different class/ category of information items. Similarly,

Lee's Fig. 6 organized items of legal information under different groups with different

headings in tabulated format, and therefore anticipates the claimed limitation "tabulated

by type of legal information".

      Applicant further argued that Lee does not disclose "at least one database

associated with the at least one computer storing the legal information in association

with a plurality of legal topics and a plurality of types of legal information". On the

contrary, Lee clearly teaches at Fig. 3 a database 20 associated with one computer 12,

storing legal information 92-102 in association with a plurality of legal topic and plurality

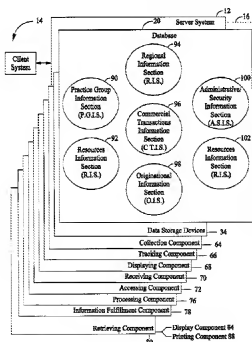of type of legal information 90, 92, 94, 96, 98, 100, 102.

FIG. 3

Applicant further argued that Lee teaches a database contains legal information but does not teaches "a single legal topic". On the contrary, Lee teaches at Fig. 6 a plurality legal topic such as Antitrust, Consumer Law.... similar to applicant definition of "legal topic" listed in claim 6.

Regarding claim **30**, applicant argued that Lee does not teach "assigning at least one identifier to each of a plurality of documents comprising legal information relating to a plurality of legal topics, wherein the at least one identifier is associated with (a) at least one legal topics and (b) at least one of plurality of types of legal information". On the contrary, Lee teaches at Col. 10 lines 34-44 the step of assigning a title (i.e. "identifier") for each document. Lee also teaches at Col. 9 lines 5-20 and Fig. 6 that each document is associated with multi-level logical groups which represent plurality of legal topic (i.e. "Antitrust", "Consumer Law"...) and plurality of types of legal information (i.e. "Practice Group", "Regional Components".)

Applicant further argued that Lee does not teaches "formatting the received document according to a protocol, storing the formatted documents in at least one database". On the contrary Lee teaches at Col. 9 lines 5-10 that document are stored in HTML format.

In light of the foregoing arguments, the 35 U.S.C 102 rejection is hereby sustained.

Conclusion

9.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Khanh B. Pham whose telephone number is (571) 272-

4116. The examiner can normally be reached on Monday through Friday 7:30am to

4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Khanh B. Pham/
Primary Examiner
Art Unit 2166

June 4, 2008